

REMARKS

Favorable reconsideration in view of the amendments and following remarks is respectfully requested.

The Examiner is thanked for the thorough examination of the application.

Claims 1-14 and 16-24 are pending. By this Amendment, claim 15 is canceled and the features therein are added to independent claim 14. Currently, claims 14, 16-19 and 22-24 are under review, claims 1-13, 20 and 21 having been withdrawn as a result of the June 25, 2008 election of species requirement. Claims 14 and 22 are independent.

The Office Action rejects claims 14, 17 and 19 under 35 U.S.C. §102(b) over U.S. Patent No. 5,224,156 to Fuller et al.; rejects claims 15, 16 and 22-24 under 35 U.S.C. § 103(a) over Fuller in view of U.S. Patent No. 5,946,386 to Rogers et al.; and rejects claim 18 under 35 U.S.C. §103(a) over Fuller in view of U.S. Patent No. 6,825,955 to Shibata. These rejections are respectfully traversed.

Applicant's independent claim 14 is directed to a fax data transmission device. Claim 14 is explained with reference to a preferred embodiment. A first storing unit is operable to store fax data and an identifier for identifying the fax data in correspondence with each other. A second storing unit is operable to store information showing a correspondence between an original destination of the fax data and a send information destination. The send information destination is a destination of send information which includes the identifier and a notification that the fax data identified by the identifier is going to be sent. A notifying unit is operable to send the send information to the send information destination corresponding to the original destination of the fax data with reference to the information stored in the

second storing unit. A receiving unit is operable to receive, as a reply to the send information, destination information from the send information destination for specifying a destination to which the fax data should actually be sent, and extracts the destination information from the reply. A sending unit is operable to send the fax data to the destination specified by the destination information. The notifying unit sends the send information via an Internet mail, and the receiving unit extracts the destination information from a mail replying to the Internet mail.

In the non-limiting example disclosed in Applicant's published specification beginning at paragraph [0145], a user of the MFP 230 instructs the MFP 230 to send a send notification destination register mail to each sender device registered in the MFP 230, including the MFP 530. The send notification destination register mail shown in Fig. 31 contains a mail address or a fax number of an original destination of fax data, and a mail address of a send notification mail destination. For example, in the send notification destination register mail, mobile telephone 410 is designated as a send notification mail destination. When fax data needs to be sent by MFP 530 to MFP 230, the MFP 530 refers to the send notification destination storing unit 539. The send notification destination storing unit 539 stores the information which designates the mobile phone 410 as the send notification mail destination corresponding to the MFP 230. Accordingly, the MFP 530 sends a send notification mail to the mobile telephone 410. The mobile telephone 410 receives the send notification mail from the MFP 530. The mobile telephone 410 then sends information for specifying a destination to which the fax status should actually be sent, as a reply mail to the send notification mail. The MFP 530 extracts information

about a send notification destination from the reply mail and sends the fax data to destination specified in the reply mail.

As described in a non-limiting example in Applicants' published specification beginning at paragraph [0079], if the fax data should be forwarded to a fax device, the user enters a fax number of the fax device in the message body of the receipt notification mail. If the fax data should be forwarded to an ifax device, the user enters a mail address of the ifax device in the message body of the receipt notification mail. MFP 230 receives the reply mail, and extracts the mail address from the reply mail as information relating to a destination to which the fax data should be forwarded. The claims are not limited to the preferred disclosed embodiments.

The Fuller patent discloses a method and apparatus for causing a message to be sent in facsimile compatible form over a telephone system from a first location to a second location and allowing delivery of facsimile information to a recipient at a remote location from a local facsimile machine. Once facsimile information is stored in a facsimile enhancement apparatus 60, an individual is notified that a facsimile message has been received. Fuller discloses informing the recipient that a facsimile message has been received by having apparatus 60 call a telephone number and output a voice message, contact a pager or beeper, or call a remote facsimile machine and send a facsimile message to the recipient notifying that a facsimile message has been received. When the recipient has been notified that a facsimile message has been stored in his mailbox, the facsimile message may be retrieved by the user calling from a facsimile machine at a remote location and instructing the apparatus 60 to transmit the facsimile message immediately.

In paragraph 7 of the Office Action, the Examiner recognizes that Fuller "does not show the send information via an Internet mail." Applicants respectfully disagree that Rogers overcomes this deficiency of Fuller. Applicants do not believe that the Examiner's arguments have met the requirements for determining obviousness under 35 U.S.C. §103(a). In paragraph 7 of the Office Action, the Examiner alleges that it would have been obvious to one having ordinary skill in the art to combine the feature of Rogers disclosed at col. 28, lines 40-55 with Fuller to arrive at the features of Applicants' dependent claim 15 to ensure the system alters the architecture and philosophy of the past, providing the user an array of new features and functions and expand the existing features. This statement is insufficient to support an obviousness rejection, particularly taking into account the Patent Offices' examination guidelines for determining obviousness under 35 U.S.C. §103(a) in view of KSR International Co. v. Teleflex Inc., 82 USPQ 2d 1385 (2007).

The guidelines state that the Examiner should clearly articulate why the claimed invention would have been obvious. For example, the Supreme Court in KSR held that the Examiner "must [provide] some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Id. at 1396. The statement by the Examiner that a modification would provide users an array of new features and functions could be applied in every situation for every invention because every invention can provide a user a new array of features. The Examiner's rationale makes everything obvious. Instead, a proper rejection must show a relation between the obviousness rejection and the specific features disclosed in the references.

In Fuller, the user calls from a facsimile machine at a remote location and instructs the apparatus to transmit the facsimile message on the same phone call. Thus, Fuller does not even contemplate the use of mail. In addition, no further information is provided as to the meaning of instructing the apparatus to transmit the facsimile message. The Examiner referred to Rogers at col. 28, lines 40-55. This portion merely discloses that when a user receives a e-mail message the call management system is notified by e-mail services. A user is notified immediately of his unread email by a highlighted e-mail button. This portion of Rogers does not even disclose that a receiving unit extracts the destination information from a mail replying to an Internet mail. In addition, it is difficult to understand how the Examiner intends to combine an Internet mail system of Rogers with the phone call required by the user in Fuller. Thus, Applicants' amended independent claim 14 is distinguishable over Fuller and Rogers either alone or in combination.

Applicant's independent claim 22 is directed to a fax data transmission system comprising, in combination with other claimed features, a portable communication device including a third receiving unit operable to receive send information from a notifying unit in a fax data transmission device, when designated as the send information destination and a replying unit operable to send destination information to the fax data transmission device. The Examiner alleges that these features are disclosed in Fuller at column 2, lines 65-68 and column 8, lines 53-55. This assertion is respectfully traversed.

In Fuller, at column 2, lines 65-68, there is a specific disclosure to a remote facsimile machine and no discussion of a portable communication device. Column

7, lines 53-55 specifically refers to an internal voice mail system and not a portable communication device.

In Fuller there are two ways to receive the message remotely. One is to have a pre-stored remote facsimile number. The second is to call from a facsimile machine at a remote location and instruct the apparatus to transmit the facsimile message immediately on the same phone call. None of these provide the advantages of using, for example, a mobile telephone 410 and specifying a destination to which the fax should actually be set. For example, the user may not be at a location that contains a facsimile machine and therefore, the user cannot immediately know if he has received a fax. Thus, the provision of the portable communication device in claim 22 provides advantages not realized by Rogers or Fuller either alone or in combination. Thus, Applicant's independent claim 22 is distinguishable over Fuller and Rogers either alone or in combination.

The dependent claims are allowable for at least the reasons discussed above as well as for the individual features they recite. For example, dependent claim 23 recites the second receiving unit extracts the destination information from the reply to the send information. Claim 24 recites the identifier is included in a message body of an internet mail. These claims are allowable for reasons similar to those discussed above with respect to amended independent claim 14. Neither of these features are disclosed in the applied references.

The Shibata reference does not overcome the deficiencies of Fuller and Rogers noted above.

Prompt and favorable examination on the merits is respectfully requested. Should any questions arise in connection with this application, or should the

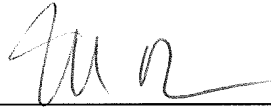
Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: November 9, 2010

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